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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,681	12/21/2001	T. Daniel Gross	16497.43	2036
57360	7590	10/30/2007		
WORKMAN NYDEGGER 1000 EAGLE GATE TOWER, 60 EAST SOUTH TEMPLE SALT LAKE CITY, UT 84111			EXAMINER YABUT, DIANE D	
			ART UNIT 3734	PAPER NUMBER
			MAIL DATE 10/30/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/027,681

Applicant(s)

GROSS ET AL.

Examiner

Diane Yabut

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2007.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 3-7 and 26-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-7 and 26-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 August 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/03)<br>Paper No(s)/Mail Date <u>10/15/07</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

This action is in response to applicant's amendment received 17 August 2007.

The examiner acknowledges the amendments made to the claims and the drawings.

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Buelna** (U.S. Patent No. **5,242,459**) in view of **Andreas** (U.S. Patent No. **5,797,929**).

Claim 3: Buelna discloses a suture trimmer comprising a shaft **16** having a proximal end and a distal end and an axis therebetween, a suture retainer **12** having a groove **58** formed in the side thereof, the groove **58** in communication with an opening **38** formed in the side of the shaft, the opening **38** disposed proximal the distal end (Figures 1 and 4). Buelna discloses a cutting member **30** and the suture retainer **12** both slidably disposed within the shaft **16** (col. 4, lines 7-13). Buelna also discloses a handle assembly, the handle disposed adjacent the proximal end of the shaft (Figure 1). Buelna discloses the handle assembly further including a first lever **60** and a second lever **62** that are operatively coupled to the suture retainer and cutting member, respectively (col. 5, lines 49-52 and lines 55-58). Buelna discloses the claimed device except for the shaft **16** having the groove formed in a side thereof, the groove being in

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communication with an opening formed in the side of the shaft, although as mentioned above does disclose the suture retainer **12** having the groove and opening.

Andreas teaches a suturing instrument **100** with an outer shaft **104** having a groove (distal end, by element **112**) formed in a side thereof, the groove being in communication with an opening **120** formed in the side of the shaft (Figure 5). It would have been obvious to one of ordinary skill in the art at the time of invention to provide the groove in communication with an opening in a shaft, as taught by Andreas, to Buelna since it was well known in the art to have a receiving opening and groove along a external surface of a suturing instrument in order to readily load sutures onto the device so that they may be effectively manipulated.

Claim 4: Buelna discloses a biasing member **40**, the biasing member **40** in communication with the cutting member **30** (col. 4, lines 32-36 and col. 5, lines 3-9).

Claim 5: Buelna discloses the opening **38** having a proximal edge and the cutting member **30** having a sharpened edge **36** which is adapted to engage the proximal edge to sever suture when suture is disposed through the groove and opening (col. 5, lines 53-55).

Claim 6: Buelna discloses a sharpened edge **36** of a cutting member **30** which is retracted within the shaft until it is withdrawn by applying a force to the second lever **62** (col. 5, lines 49-52).

Claim 7: Buelna discloses a suture that is disposed within the groove **58** and opening **38** by retracting the suture retainer within the shaft **16** by applying a force to the first lever **60** (col. 5, lines 29-33).

3. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Buelna** (U.S. Patent No. **5,242,459**) in view of **Andreas** (U.S. Patent No. **5,797,929**), as applied to claim 3 above, and further in view of **Rosenbluth** (U.S. Patent No. **5,312,423**).

Claim 26: Buelna and Andreas disclose the claimed device except for the suture retainer being slidably disposed within the cutting member.

Rosenbluth teaches a suture retainer **23** being slidably disposed within a cutting member **12** having cutting edge **86** (Figures 7 and 26, col. 5, lines 35-58 and col. 8, lines 24-40). It would have been obvious to one of ordinary skill in the art at the time of invention to provide the suture retainer within the cutting member, as taught by Rosenbluth, to Buelna and Andreas in order to better secure the suture within the device by keeping it internal to the cutting device.

4. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Buelna** (U.S. Patent No. **5,242,459**) in view of **Andreas** (U.S. Patent No. **5,797,929**), as applied to claim 3 above, and further in view of **Nobles** (U.S. Patent No. **6,733,509**).

Claim 27: Buelna and Andreas disclose the claimed device except for the cutting member having a proximally facing cutting edge.

Nobles teaches a suture cutter with a cutting member having a proximally facing cutting edge **124** (Figure 3A). It would have been obvious to one of ordinary skill in the art at the time of invention to provide a proximally facing cutting edge, as taught by Nobles, to Buelna and Andreas in order to secure and trim back a suture rapidly and accurately in one device (col. 1, lines 31-33).

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5. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Buelna** (U.S. Patent No. **5,242,459**) in view of **Andreas** (U.S. Patent No. **5,797,929**), as applied to claim 3 above, and further in view of **Sancoff** (U.S. Pub. No. **20020010480**).

Claim 28: Buelna and Andreas disclose the claimed device except for the first lever and the second lever each being movable with respect to the handle.

Sancoff teaches a first lever **22** and a second lever **24** each being movable with respect to a handle **14**, which actuate a suture retainer and cutting member, respectively (Figure 2). It would have been obvious to one of ordinary skill in the art at the time of invention to provide a first lever and a second lever being each movable with respect to a handle, as taught by Sancoff, to Buelna and Andreas since it was well known in the art to use levers to facilitate actuation of cutting and retaining members in surgical devices.

### ***Response to Arguments***

6. Applicant's arguments filed 17 August 2007 have been fully considered but they are not persuasive.

7. The applicant generally argues that neither Buelna nor Andreas, or the combined device of Buelna and Andreas discloses each and every element of claim 3. The examiner disagrees. Buelna teaches a *suture retainer* having a groove **58** formed in a side thereof, which is in communication with an opening **38** formed in the side of the shaft (Figure 1), instead of the *shaft* having the groove and the opening. Andreas teaches a suturing device with a *shaft* **104** having a groove (near **112**) formed in a side

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thereof, which is in communication with an opening 120 formed in the side of the shaft (Figure 5). As maintained above, it would have been obvious to one of ordinary skill in the art at the time of invention to provide the groove in communication with an opening in an outer shaft, as taught by Andreas, to Buelna since it was well known in the art to have a receiving opening and groove along a external surface of a suturing instrument in order to readily load sutures onto the device so that they may be effectively manipulated.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diane Yabut, whose telephone number is (571) 272-6831. The examiner can normally be reached on M-F: 9AM-4PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on (571) 272-4959. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DY



MICHAEL J. HAYES  
SUPERVISORY PATENT EXAMINER